



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

COMISKEY et al

Serial No.: 08/240,895

Filed: May 11, 1994

For: REFLECTED LIGHT GLARE  
MINIMIZATION ...

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June 8, 1995

Honorable Commissioner of Patents and  
Trademarks  
Washington, DC 20231

PETITION TO THE COMMISSIONER UNDER 37 CFR 1.181  
TO ORDER ENTRY OF THE REPLY BRIEF

**THIS CASE HAS BEEN GRANTED SPECIAL  
STATUS**

Sir:

Petition is hereby made for entry of the reply brief in this case. An appeal brief was filed on February 17, 1995. On May 15, 1995 an Examiner's Answer was mailed. In the Examiner's Answer there were numerous more detailed arguments submitted than in the Final Rejection. These arguments had not been made earlier in the case as an inspection of the Final Rejection makes clear (paper no. 7 mailed October 18, 1994). On May 19, 1995 a reply brief was filed. The reply brief was directed specifically to, and only to, the new arguments raised in the Examiner's Answer. On June 5, 1995 the examiner issued a paper stating



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Atty Ref.: 1723-4

Group: 1513 - D

Examiner: Macholl

that the reply brief has not been entered "because it is not directed only to new points of argument raised in the Examiner's Answer." Petition is hereby made for an order requiring the examiner to enter the reply brief before the case is forwarded to the Board of Appeals.

On page 6 of the Examiner's Answer with respect to claims 9 and 10 the phrases "primarily" and "most" were specifically discussed. The discussion here was different than on page 3 of the Final Rejection, raising new points of argument. Therefore appellant was completely proper in responding to these new points of argument on page 2 of the reply brief.

In the paragraph bridging pages 4 and 5 of the Examiner's Answer, and in the first full paragraph on page 5 of the Examiner's Answer, new points of argument were made by the examiner regarding the propriety of the term "substantially". In particular note that the examiner greatly expanded the discussion regarding substantially eliminating the reflection of direct or indirect light, and in discussing the use of "substantially" in other patent claims conceded that there were hundreds of thousands of patents which included that language in the claims. Neither the expanded argument regarding indirect or direct light, nor the concession of the term "substantially" being in the claims of hundreds of thousands of other patents, were made in the Final Rejection (see page 4 thereof), therefore there clearly and unequivocally were new points of arguments in the Examiner's Answer that appellant was entitled to respond to.

On page 8 of the Examiner's Answer where the "predefined clearly demarcated geometric shape" limitation was discussed, the analysis of this

limitation and its discussion included numerous new points of argument that were not made in the original discussion of this issue on pages 5 and 6 of the Final Rejection. Since new points of argument were raised in discussing this issue, appellant had every right to respond to those new points of argument as appellant did on page 3, first full paragraph, of the reply brief.

In the paragraph bridging pages 13 and 14 of the Examiner's Answer the issue of the participants in athletic contests being fans and cheerleaders was discussed. This particular discussion specifically impacted on the points of argument made on page 9 of the Examiner's Answer. This same new point of argument was also addressed in the paragraph bridging pages 5 and 6 of the reply brief. Nowhere is this point of argument found in the Final Rejection. Therefore it is a new point of argument, and appellant had every right to respond to it as appellant did in the last paragraph on page 3 of the reply brief.

In the first full paragraph on page 13 of the Examiner's Answer the issue of the negative teachings in the prior art about putting tattoos near one's eyes was discussed in the detail provided there for the first time. Compare the arguments and discussion in the first full paragraph on page 13 of the Examiner's Answer with the third and fourth paragraphs on page 7 of the Final Rejection. Since numerous new points of arguments were made regarding this issue, appellant had every right to respond thereto as appellant did on pages 4 and 5 of the reply brief.

In the second full paragraph on page 13 of the Examiner's Answer it was stated for the first time that the claims do not exclude reflectively colored portions. This statement was never made in the Final Rejection as an inspection thereof

makes clear. Therefore this was a new point of argument that appellant had every right to respond to, as appellant did in the first full paragraph on page 5 of the reply brief.

In the second full paragraph on page 6 of reply brief comments regarding the grouping of claims portion of the Examiner's Answer were made. Since there was no comment regarding grouping of claims in the Final Rejection this was a new point of argument and appellant had every right to respond to it.

The last paragraph on page 6 of the reply brief was a summary argument relating to all of the new points of arguments raised in the Examiner's Answer, collectively, and drawing conclusions based thereon. It is just as appropriate for appellant to make general comments in response to all of the new points of arguments, as it was to respond individually to each new point of argument.

In summary, appellant has demonstrated that every single aspect of the reply brief was specifically related to a new point of argument raised in the Examiner's Answer. The paper issued June 5, 1995 does not in any way, shape or form point out what aspect of the reply brief was not directed to a new point of argument, and is deficient in that regard. It appears that denial of entry of the reply brief is being made solely because it contains arguments responsive to the Examiner's Answer new points of arguments that are so persuasive that it enhances appellant's probability of prevailing on appeal, and shows the examiner's use of the English language to be incorrect. Therefore it is respectfully requested that the examiner be ordered to enter the reply brief forthwith, and to send this case to the Board of Appeals.

Since the rules of practice do not indicate any fee associated with this petition, no fee is enclosed. However if for some reason the undersigned has misinterpreted the requirement for a fee, the Commissioner is hereby authorized to charge any fee which must be filed for consideration of this paper to our account no. 14-1140, our order no. 1723-4. A duplicate copy of this paper is provided.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:



Robert A. Vanderhye  
Reg. No. 27,076

RAV:eaw  
1100 North Glebe Road  
8th Floor  
Arlington, VA 22201-4714  
Telephone: (703) 816-4004  
Facsimile: (703) 816-4100